

Appl. No. 10/088,699
Amdt, dated December 2, 2003
Supplemental Response to Restriction Requirement of
October 3, 2003.

PATENT
Attorney docket number 082376-000000US

REMARKS/ARGUMENTS

Claims 1-13 were subject to restriction. Claims 1-5, 7-11 and 13 are previously presented. Claims 6 and 12 are original.

In Applicant's previous response to the restriction requirement, Applicant elected Group I with traverse. The response presented a claim listing that was not in compliance with the permissible claim status identifiers. This supplemental response presents a claim listing which is in compliance with the permissible claim status identifiers. The instant claim listing uses claim identifiers which reflect entry of the preliminary amendment filed March 18, 2002. The original response to the restriction requirement inadvertently identified previously presented claims as original claims. For the Examiner's convenience, Applicant has repeated the entire response filed November 11, 2003, as follows:

Claims 1-13 are pending in the present application. The Examiner has requested that the Applicant elect one group under 35 U.S.C. §121 as follows:

- I. Claims 1, 2, 4-8, and 10-13 drawn to a method of screening the suppressive effects of a nucleic acid on a disorder that accompanies cell death.
- II. Claim 1, 3-7 and 9-13, drawn to a method of screening the suppressive effects of a protein on a disorder that accompanies cell death.

Applicant hereby elects to prosecute Group I (Claims 1, 2, 4-8, and 10-13) with traverse.

Unity of invention exists when there is a special technical relationship among the claimed inventions involving one or more special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. PCT Rule 13.2.

Here, the Group I and Group II claims share a special technical feature, namely, deriving a molecule from a cell from an area in an organism affected by a disorder that accompanies cell death. The selection of molecules from areas affected by the disorder yields a different set of molecules (proteins or nucleic acids) than would arise from selection of

Appl. No. 10/088,699
Amdt. dated December 2, 2003
Supplemental Response to Restriction Requirement of
October 3, 2003.

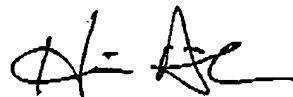
PATENT
Attorney docket number 082376-000000US

molecules from areas not affected by the disorder. This aspect of the special technical feature is described, for example, in the paragraph spanning pages 3-4. Because there is no art of record disclosing this special technical feature, it distinguishes each of the claimed inventions as a whole over the prior art.

This conclusion is not changed by the possible existence of other technical features that differ between the Group I and Group II claims. Thus, in the office action, the Examiner notes that the Group I claims are directed to nucleic acids and the Group II claims to polypeptides. However, the claims still share the special technical feature discussed above. The existence of single special technical feature common to the two Groups of claims is sufficient to confer unity of invention.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Harrison F. Dillon
Reg. No.: 45,661

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
HFD:j4r
60091136 v1